

REMARKS

Claims 1, 8, 11, and 18 have been amended. Accordingly, claims 1, 2, 4-14 and 18-28 are currently pending in the application, of which claims 1, 8, 11, and 18 are independent.

Applicant respectfully submits that the above amendments do not add new matter to the application and are fully supported by the specification. Support for the amendments may be found at least at pages 11, line 22; page 13, lines 23-24; page 16, lines 1-6; and page 18, lines 10-13 of the specification.

In view of the above amendments and the following Remarks, Applicant respectfully requests reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

Rejections Under 35 U.S.C. § 112, first paragraph

Claims 1-2, 4-14 and 18-28 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicant respectfully traverses this rejection for at least the following reasons.

Generally, the requirements of 35 U.S.C. §112, first paragraph, are that the written description demonstrate to one of ordinary skill in the art that the inventor is in possession of the invention itself. Union Oil Co. v. Atlantic Richfield Co., 54 USPQ2d 1227, 1232-33 (Fed. Cir. 2000), In re Hayes Microcomputer Prods., Inc. Patent Litigation, 25 USPQ2d 1241, 1245 (Fed. Cir. 1992). In addition, the mere fact that the words used in the claims are not used in the specification *in haec verba* by using the same words does not necessarily mean that the specification does not describe the subject matter of the invention. MPEP 2163.02. As such, the requirements of 35 U.S.C. §112, first paragraph, do not demand that all details of an invention must be put forth in the written description using the same descriptive terminology. Instead, the question is whether the written description provides sufficient details of the

invention such that the disclosure "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." In re Hayes Microcomputer Products, Inc. Patent Litigation, 25 USPQ2d at 1245 quoting Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991); see, Union Oil Co. v. Atlantic Richfield Co., 54 USPQ2d at 1233.

Here, such details for the features of claims 1, 8, 11, and 18 are provided at least at:

1. Page 13, lines 16-20: "[I]f the incoming message is a call, the incoming message alarming information may include the identification ...of the calling mobile communication terminal 10 and the information indicating the incoming call's arrival." (emphasis added)
2. Page 16, lines 3-6: the "incoming message alarming information [indicates] that the called mobile communication terminal 90 is being called or a short message is arriving." (emphasis added)
3. Page 19, lines 20-22: "it is made possible to readily recognize the incoming message's arrival at the mobile communication terminal." (emphasis added)
4. Figure 2: an incoming message recites "YOU ARE BEING CALLED BY 000-000-0000." (emphasis added)

These cited portions of the specification support at least "the second notification message to provide notification that the called mobile communication terminal is currently receiving the incoming message notification message." (emphasis added). Individually and collectively, these cited portions of the specification, together with the remainder of the specification, "reasonably convey to one skilled in the relevant art that the inventor, at the time application was filed, had possession of the claimed invention." Thus, the claims are supported by the specification in compliance with the written description requirement of 35 U.S.C. § 112, first paragraph.

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, first paragraph rejection of claims 1-2, 4-14 and 18-28.

Further, claims 27-28 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Specifically, the examiner asserts that the features of these claims, including "wherein the messenger service system determines whether a called subscriber is logged into the messenger service system, the called subscriber corresponding to the called mobile communication terminal," were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time application was filed, had possession of the claimed invention. Applicant respectfully traverses this rejection for at least the following reasons.

Support for the features of claims 27-28 may be found at least at the following locations in the specification:

1. Page 13, lines 8-15: "It is checked whether or not the called subscriber has logged in the messenger service, by using the messenger ID. Then, when the called subscriber has logged in the messenger service, incoming message alarming information indicating the incoming message's arrival is transmitted to the personal computer 80 which the called subscriber has logged in over the Internet 70 by using the searched IP address.." (emphasis added)
2. Page 15, lines 8-10: "the incoming message alarming information indicating the incoming message's arrival is transmitted over the Internet 70 to the personal computer 80 which the called subscriber has logged in." (emphasis added)
3. Page 17, lines 21-23: "Then, it is checked whether or not the called subscriber has logged in the messenger service through the personal computer 80 by using the searched messenger ID (S43)."

Individually and collectively, these cited portions of the specification "reasonably convey to one skilled in the relevant art that the inventor, at the time application was filed, had possession of the claimed invention." Thus, the use of the phrases in claims 27-28 are supported by the specification in compliance with the written description requirement of 35 U.S.C. § 112, first paragraph.

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, first paragraph rejection of claims 27-28.

Rejections Under 35 U.S.C. § 103

To establish an obviousness rejection under 35 U.S.C. § 103(a), four factual inquiries must be examined. The four factual inquiries include (a) determining the scope and contents of the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966).

In view of these four factors, the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007). The Federal Circuit requires that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

Finally, even if the prior art may be combined, there must be a reasonable expectation of success, and the reference or references, when combined, must disclose or suggest every claimed feature. See *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-2, 4, 8-14 and 18-26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0111167 applied for by Nguyen *et al.* ("Nguyen") in view of U.S. Patent No. 6,493,431 issued to Troen-Krasnow, *et al.* ("Troen-Krasnow"), further in view of U.S. Patent Application Publication No. 2001/0043591 applied for by Nance, *et al.* ("Nance").

Even if the cited references could be combined, the combination fails to disclose every feature of the claims as amended. Claim 1 as amended recites, in relevant part, "wherein ... the personal computer displays a content of the incoming message when the second notification message is received." The references even if combined, fail to disclose such features. Claims 8, 11, and 18 have been amended consistently with claim 1. Accordingly, for at least these same reasons, even if the cited references could be combined, the combination fails to disclose every feature of claims 8, 11, and 18 as amended.

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 8, 11, and 18. Claims depending from claims 1, 8, 11, and 18 are allowable at least for this reason. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicant submits that independent claims 1, 8, 11, and 18, and all the claims that depend therefrom, are allowable.

Claims 5-7 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Nguyen in view of Troen-Krasnow, further in view of Nance, still further in view of U.S. Patent Application Publication No. 2004/0253975 applied for by Shiraogawa, *et al.* ("Shiraogawa").

Applicant respectfully submits that claim 1 is allowable over Nguyen, further in view of Troen-Krasnow, further in view of Nance, and Shiraogawa fails to cure the deficiencies noted above with regard to claim 1. Hence, claims 5-7 are allowable at least because they depend from an allowable base claim.

Claims 27-28 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Nguyen in view of Troen-Krasnow, further in view of Nance and still further in view of "well known prior art."

Applicant respectfully submits that claim 1 is allowable over Nguyen in view of Troen-Krasnow, further in view of Nance, and the alleged "well known prior art" fails to cure the deficiencies noted above with regard to claim 1. Hence, claims 27-28 are allowable at least because they depend from an allowable base claim.

CONCLUSION

A full and complete response has been made to the pending Office Action, and all of the stated grounds for rejection have been overcome or rendered moot. Accordingly, all pending claims are allowable, and the application is in condition for allowance.

The Examiner is invited to contact Applicant's undersigned representative at the number below if it would expedite prosecution. Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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